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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/700,798 | 11/03/2003 | Glen Van Datta | 450133-04863.1 | 6261 |
| 20/999 7590 12/18/2008 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151 | | | | |
| EXAMINER | | | | |
| OSMAN, RAMY M | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2457 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 12/18/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/700,798

Applicant(s)

DATTA ET AL.

Examiner

RAMY M. OSMAN

Art Unit

2457

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
4a) Of the above claim(s) 1-23 and 45-52 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 24-44 and 53 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This communication is responsive to RCE amendment filed on October 28, 2008. Claims 24-44 and 53 are pending.

Response to Arguments

2. Applicant's arguments, filed 10/28/2008, with respect to the rejection(s) of claim(s) 24-44 and 53 have been fully considered but are not persuasive.
3. Applicant argues that the submitted Declaration, filed on 9/25/2008 under 37 CFR 1.131, establishes inventorship of the instant application prior to 4/9/2002, i.e. the Ramanathan reference (US Patent No 7174382).

In reply, Applicants Declaration is insufficient to establish prior inventorship. See Response to Declaration below.

Response to Declaration

4. The Declarations filed on 9/25/08 under 37 CFR 1.131 has been considered but is ineffective to overcome the Ramanathan reference.
5. The submitted Declarations fails to contain an executed declaration for Glen Datta. All inventors are required to submit an Affidavit/Declaration unless it can be shown otherwise in accordance with **MPEP 715.04**.
6. In Applicants "Remarks/Arguments" Applicant states that "*Ramanathan is not prior art because the invention was conceived and reduced to practice prior to ... April 9, 2002.*"

CONCEPTION

7. Applicant submits that the email attachment presented in Exhibit A satisfies conception prior to April 9, 2002.

In reply, Exhibit A does provide sufficient evidence to establish that the invention was conceived prior to 4/9/2002.

REDUCTION TO PRACTICE

8. Applicant submits that the source code presented in Exhibits B and C establishes a reduction to practice of each of the claim elements of claim 24, and is prior to 4/9/2002.

In reply, although Applicants have attempted to show that the invention existed in code form and to show each of the limitations of the claims in code form, the submitted Declarations fails to provide and point out evidence that the invention actually existed and worked for its intended purpose in an appropriate environment (see MPEP 715.07). Applicant is required to show that the invention existed in a physical/tangible form that shows every element of the invention, as claimed, in a functioning example (see MPEP 2138.05 section II). Some sort of benchmark or laboratory testing are necessary to show that the invention worked for its intended purpose, and that the results are repeatable and consistent (see MPEP 2138.05 section III).

Therefore, Applicant has not shown reduction to practice since Applicant has not demonstrated sufficient evidence to show that the invention existed in a physical or tangible form that shows every element of the claimed invention.

Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established by what exhibit, and what facts are relied upon by applicant. General statements and assertions by the Applicant that the exhibits describe a reduction to practice “amounts to mere pleading, unsupported by proof or a showing of facts” (see MPEP 715.07 section I).

The evidence submitted also lacks any statement or evidence which supports that a reduction to practice of the invention was performed in this country or a NAFTA or WTO member country prior to the effective date of the Ramanathan reference.

DILIGENCE

9. Since Applicant has not satisfied the requirements needed to demonstrate an actual reduction to practice, then Applicant may attempt to antedate the reference by demonstrating conception of the invention prior to the date of the reference coupled with due diligence from prior to the reference date until the filing date of the instant application. Applicant would be required to demonstrate reasonable diligence during the critical period which begins prior to the date of the reference and ends with either the filing of the US application or with a demonstrated actual reduction to practice (see MPEP 715.07 (a)). The entire critical period must be accounted for by either affirmative acts or acceptable excuses.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Ramanathan reference to either a constructive reduction to practice or an actual reduction to practice.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 24-44,53 rejected under 35 U.S.C. 102(e) as being anticipated by Ramanathan (US Patent No 7,174,382).

12. For detailed rejection, see Office Action dated 8/6/2008.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAMY M. OSMAN whose telephone number is (571)272-4008. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ramy M Osman/
Primary Examiner (Temp), Art Unit 2457

December 15, 2008